

Pippig *et al.*  
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### REMARKS

Applicant's undersigned representative appreciates the courtesies extended by Examiner Li during the telephone conversation of June 11, 2003, during which the Declaration under 37 C.F.R. § 1.131 was discussed.

#### *Prior Art-Based Claim Rejections/ Declaration under 37 C.F.R. § 1.131*

As set forth in the Final Rejection of June 3, 2003, claims 1-4, 6-8, 11, and 12 remain rejected under 35 U.S.C. § 102(a) as being anticipated by Zhou *et al.*, *J. Cell Biology* 146:1133-146, September 6, 1999; claims 9, 14, 17, 19, and 20 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Bordignon *et al.* (WO 95/06723, March 9, 1995) in view of Zhou *et al.*; and claim 18 remains rejected under 35 U.S.C. § 103(a) as being unpatentable over Bordignon *et al.* in view of Zhou *et al.*, and further in view of either Persons *et al.*, *Blood* 90:1777-1786, 1997, or Hildinger *et al.*, *Gene Therapy* 6:1222-1230, 1999.

The Examiner indicated in the Final Office Action that the prior art rejections remained because the Declaration under 37 C.F.R. § 1.131 submitted in Applicant's previous response was ineffective to overcome the rejection because it was not signed by all the inventors, owners, or a party qualified under 1.42, 1.43, or 1.47, and that Lynn-Marcus Wyner does not qualify.

As Applicant's undersigned representative indicated on the telephone to Examiner Li, the Declaration under 37 C.F.R. § 1.131 submitted in Applicant's previous response was in fact signed by both of the inventors, Susanne Pippig and Gabor Veres. Attached hereto is a copy of the Postcard Filing Receipt, date-stamped by the PTO on March 3, 2003, which acknowledges receipt of the Declaration of Prior Invention of the Inventors, including Exhibits A & B.

In case the originally submitted copies became separated from the Office's file, included herewith are additional copies of the Declaration of Prior Invention under § 1.131. Note that one inventor (Susanne Pippig) signed one copy, and the other inventor (Gabor Veres) signed the other copy. Exhibits A & B are not being resubmitted herewith, because it is apparent from the

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Final Office Action that they were already received by the Office, and Examiner Li confirmed on the telephone that they were in fact received.

Applicant respectfully notes that the Affidavit of Lynn Marcus-Wyner, which was referred to in the Final Office Action as constituting an ineffective § 1.131 Declaration, was not intended to be a § 1.131 Declaration at all. It was simply Exhibit B of the § 1.131 Declaration of the Inventors and was included to authenticate the Declaration's Exhibit A (the draft patent application).

Accordingly, upon consideration of the Declaration of Prior Invention under 37 C.F.R. § 1.131 swearing behind Zhou *et al.*, which was signed by both inventors Susanne Pippig and Gabor Veres, Applicant respectfully submits that the outstanding prior art rejections should be withdrawn.

***Declaration/§ 119(e) Benefit Claim***

On pages 2-3 of the Final Office Action, the Examiner mentioned that the Supplemental Declaration submitted on March 31, 2003, in Paper No. 17, fails to claim the benefit under 35 U.S.C. § 119(e) of the provisional application, 60/266,331, filed on March 30, 2000.

Applicant respectfully notes that the benefit claim to Provisional Application No. 60/266,331 is set forth in the first paragraph of the specification. See Applicant's "Reply to Restriction/Election Requirement With Amendment," filed August 13, 2002, which replaced the original benefit claim in the specification (which listed a non-provisional application that was later converted to a provisional application) with an updated benefit claim that listed the provisional application number assigned to the application following conversion. In particular, page 1, lines 4-8 were updated to read: "This application claims the benefit under 35 USC §119(e) of the following United States provisional patent application: Provisional Application No. 60/266,331, filed March 30, 2000." Applicant fully intends to claim the benefit of this provisional application.

The Supplemental Declaration submitted on March 31, 2003, in Paper No. 17, does not include the benefit claim under 35 USC §119(e) because there is no requirement in the statutes or rules to set forth domestic priority claims in a declaration. The PTO has addressed this issue in

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the "PBG and AIPA Rulemaking and Patent Examination Guidelines – March 2001 – Training and Implementation Guide." This information is available on the PTO's PBG website at: <http://www.uspto.gov/web/offices/dcom/olia/pbg/index.html> (click on the link titled "Questions & Answers (Q & A's)" on the left side of the page). Question and Answer "F2" reads:

**F2. I noticed that the new declaration forms no longer have a box to claim domestic priority under 35 U.S.C. 119(e) and 120. Why was this deleted from the forms?**

The domestic priority box was removed from the declaration forms because it is not required by the statutes or by the related rules to state a domestic priority claim in the declaration. The presence of this box created confusion, and may have caused unnecessary objections to declarations when this box was not filled out and applicant was indeed claiming domestic priority to another application. To claim domestic priority under 35 U.S.C. 119(e) and 120, applicant must comply with 37 CFR 1.78 which requires, in part, that the priority claim information be in either the first line of the specification or in an application data sheet.

Applicant notes that the Supplemental Declaration submitted on March 31, 2003, was generated using Form PTO/SB/O4 downloaded from the Forms page on the PTO's website (<http://www.uspto.gov/web/forms/index.html>).

Accordingly, Applicant respectfully submits that the present application is entitled to the benefit under 35 USC §119(e) to Provisional Application No. 60/266,331 by virtue of the first line of the specification. Applicant also respectfully submits that the Supplemental Declaration submitted on March 31, 2003, fully complies with the relevant statutes and rules.

In view of the above remarks, it is respectfully submitted that the instant application is ready for allowance. If any additional information is needed, the Examiner is invited to call Applicant's undersigned representative at (301) 258-4715.

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Respectfully submitted,



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